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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,936	07/14/2003	Andreas Bacher	WAS 0595 PUS	6648
22045	7590	11/23/2005	EXAMINER	
BROOKS KUSHMAN P.C., 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			RONESI, VICKEY M	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/618,936		BACHER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Vickey Ronesi		1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

1. All outstanding rejections except for the one below are withdrawn in light of applicant's amendment filed on 9/9/2005.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

#### ***Claim Rejections - 35 USC § 103***

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling et al (US 4,879,336) in view of Maruyama et al (US 4,617,239).

The rejection is adequately set forth in paragraph 5 of Office action mailed 6/16/2005 and is incorporated here by reference.

#### ***Response to Arguments***

5. Applicant's arguments filed 9/9/2005 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that while Schilling teaches the use of additional comonomers, it does not disclose or suggest silane-containing monomers; (B) that the copolymers of Maruyama are unstable as evidenced by comparative data in the present specification; and (C) that the problem solved by applicants is to avoid premature gelation which is not taught or suggested in either Schilling or Maruyama.

With respect to argument (A), the fact that Schilling does not disclose the use of a silane-containing comonomer is precisely the reason why Maruyama was utilized for its teachings regarding the benefits of silane in paper coating agents such as improved water resistance, printability, surface strength, and barrier properties. Had Schilling taught the silane-containing monomer, the combination with Maruyama would not have been made or needed.

With respect to argument (B), while the copolymer of Maruyama may be unstable, the copolymer itself of Maruyama was not utilized in the outstanding rejection. Rather, Maruyama taught the benefits of silane-containing monomers in paper coating agents which are similar to those disclosed by Schilling. The copolymer of Schilling does not have a gellation problem due to the presence of the alkyl vinylacetate and would not be expected to have a gellation problem if an additional monomer such as the silane-containing monomer was further included.

With respect to argument (C), the examiner has not found support for the avoidance of premature gellation in applicant's application as originally filed. While Table 3 shows the improved storage stability of a copolymer with alkyl vinylacetate comonomer, nothing seems to suggest an avoidance of premature gellation which would presumably occur before storing. If applicant is referring to the improved storage stability, such *is* taught by Schilling (col. 2, lines 7-34).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### *Contact Information*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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11/18/2005

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*W*

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